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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/557,796	04/25/2000	James Hoch	252/123	8950

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EXAMINER

LACOURCIERE, KAREN A

ART UNIT	PAPER NUMBER
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1635

DATE MAILED: 10/24/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action

Application No.

09/557,796

Applicant(s)

HOCH ET AL.

Examiner

Karen A. Lacourciere

Art Unit

1635

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 14 October 2003 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

PERIOD FOR REPLY [check either a) or b)]

- a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.
- b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection. ONLY CHECK THIS BOX WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. ☐ A Notice of Appeal was filed on _____. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will not be entered because:
- (a) ☒ they raise new issues that would require further consideration and/or search (see NOTE below);
- (b) ☐ they raise the issue of new matter (see Note below);
- (c) ☒ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
- (d) ☐ they present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: See Continuation Sheet.

3. ☒ Applicant's reply has overcome the following rejection(s): See Continuation Sheet.
4. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).
5. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because: See Continuation Sheet.
6. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
7. ☒ For purposes of Appeal, the proposed amendment(s) a) ☒ will not be entered or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: 130.

Claim(s) rejected: 99-105, 107-109 and 131-136.


Claim(s) withdrawn from consideration: _____.

8. ☐ The proposed drawing correction filed on _____ is a) ☐ approved or b) ☐ disapproved by the Examiner.
9. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____.
10. ☐ Other: _____

Continuation of 2. NOTE: Applicant's amendment to claim 99 adds the limitation wherein the nucleic acids are recombinant, which would require a new search and further considerations. Applicant's amendments to claim 135 would require a new search and introduce issues under 35 USC second paragraph, for example, due to the term "derived from" and due to the fact that polypeptides do not comprise promoters, but rather nucleic acids encoding polypeptides comprise promoters. Applicant's amendments to claim 135 would require new considerations, for example, a modified rejection under 35 USC 112, first paragraph, written description.

Continuation of 3. Applicant's reply has overcome the following rejection(s): If entered, Applicant's amendments would overcome the rejections of record under 35 USC 102 as anticipated by Anderson et al., Wood et al. or Badia et al, however, these amendments have not been entered. If entered, Applicant's amendments would overcome the rejection of record under 35 USC 112, second paragraph, directed to the term "Yia-operon related polypeptides" however, these amendments have not been entered and would require new rejections to be made under 35 USC 112, second paragraph, as discussed above.

Continuation of 5. does NOT place the application in condition for allowance because: Applicant's arguments directed to the rejections of record under 35 USC 102 are directed to the proposed amendments, filed Oct 14, 2003, however, these amendments have not been entered. Applicant's arguments directed to the rejection of record under 35 USC 112, first paragraph, as lacking adequate written description are not persuasive. Applicant argues that the amended claims, directed to promoters derived from Yia operon polypeptides are sufficiently described because 9 different yia operon polypeptides have been described in the specification, however, for these 9 polypeptides, the promoters have not been described, nor have a sufficient number of other species from the very broad genus of Yia polypeptide promoter been described or a sufficient number of the broad genus of promoters derived from Yia operon polypeptides been described, such that the skilled artisan would recognize that the inventors were in possession of the broad, highly variant genus of promoters or cells comprising such.


KAREN A. LACOURCIERE, PH.D
PRIMARY EXAMINER